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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,871	08/27/2003	Paul Kotik	7158-217	4910
7590		10/05/2004		
Ira J. Schaefer, Esq. Clifford Chance US LLP 200 Park Avenue New York, NY 10166				
EXAMINER				
HONG, HARRY S				
ART UNIT		PAPER NUMBER		
2642				

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED
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Office Action Summary

Application No.

10/648,871

Applicant(s)

KOTIK ET AL.

Examiner

Harry S. Hong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 55 and 57-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 55 and 57-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8-27-03.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The Preliminary Amendment filed on August 27, 2003 has been entered.

Specification

2. The disclosure is objected to because of the following informalities: Please fill in the Patent Number in the first paragraph of page 1 of the specification.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 55 and 57-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over DuVal (US 5,818,836; cited in the parent applications and applied for the first time in the present application).

Regarding claim 55, refer to the Abstract and to column 9, lines 47 - 50 where the claimed data relating to communications initiation criteria reads on the matchcode and time (read as the temporal data). DuVal teaches initiating communication by processing the matchcode and time and determining that the criteria have been met; the criteria being that the matchcodes and the time match.

Regarding claims 57-64, refer from column 4, line 54 to column 6, line 11 where DuVal plainly teaches the claimed method in a variety of telecommunications environments.

However, DuVal fails to teach the e-mail or instant-messaging feature of claim 55. However, e-mail and instant-messaging are well known in the art as other forms of communication requiring some form of communication processing. Therefore to apply the method of DuVal for e-mail and instant-messaging would have been a clear matters of design choice well within the capability of even one of ordinary skill in the art.

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7. Claims 55 and 57-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zwick (US 5,701,340; cited and applied in the parent applications and applied for the first time in the present application) in view of DuVal.

Refer to FIG 1 and from column 2, line 43 to column 3, line 34 of Zwick where the claimed data relating to communications initiation criteria reads on the conference identifier. Zwick teaches that the communication is initiated by processing the identifier and determining that the criteria has been met; the criteria being that the identifiers match.

Zwick fails to teach the e-mail or instant-messaging of claim 55. However, e-mail and instant-messaging are well known in the art as other forms of communication requiring some form of communication processing. Therefore to apply the method of Zwick for e-mail and instant-messaging would have been a clear matters of design choice well within the capability of even one of ordinary skill in the art.

Zwick also fails to teach the data processed comprising temporal data as recited in claim 55. However, DuVal, as applied above, plainly teaches the data processed comprising temporal data. Refer to column 9, lines 47 –50 of DuVal, where the claimed temporal data reads on the time. Therefore, lacking criticality, it would have been obvious even to one of ordinary skill in the art at the time of the invention to incorporate temporal data as part of the data relating to communications initiation criteria as motivated by DuVal.

Zwick is also silent with respect to the different telecommunications environments recited in claims 57-64. However, DuVal, as applied above, plainly teaches the claimed

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method implemented in a variety of telecommunications environments from column 4, line 54 to column 6, line 11. Therefore, lacking criticality, it would have been obvious even to one of ordinary skill in the art at the time of the invention to implement the claimed method also taught by Zwick in a variety of telecommunications environments as motivated by DuVal.

8. Claims 55 and 57-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over or Leipow (US 6,148,067; cited and applied in the parent applications and applied for the first time in the present application) in view of DuVal.

Refer to the Abstract and to FIGs 5 and 7 of Leipow where the claimed data relating to communications initiation criteria reads on the user's ID or the voice room name. Leipow teaches that the communication is initiated by processing the respective user's ID or the voice room name and determining that the criteria has been met; the criteria being that the respective user's ID or the voice room name match.

Leipow fails to teach the e-mail or instant-messaging of claim 55. However, e-mail and instant-messaging are well known in the art as other forms of communication requiring some form of communication processing. Therefore to apply the method of Leipow for e-mail and instant-messaging would have been a clear matters of design choice well within the capability of even one of ordinary skill in the art.

Leipow also fails to teach the data processed comprising temporal data as recited in claim 55. However, DuVal, as applied above, plainly teaches the data processed comprising temporal data. Refer to column 9, lines 47 -50 of DuVal, where the claimed temporal data reads on the time. Therefore, lacking criticality, it would have

been obvious even to one of ordinary skill in the art at the time of the invention to incorporate temporal data as part of the data relating to communications initiation criteria as motivated by DuVal.

Leipow is also silent with respect to the different telecommunications environments recited in claims 57-64. However, DuVal, as applied above, plainly teaches the claimed method implemented in a variety of telecommunications environments from column 4, line 54 to column 6, line 11. Therefore, lacking criticality, it would have been obvious even to one of ordinary skill in the art at the time of the invention to implement the claimed method also taught by Leipow in a variety of telecommunications environments as motivated by DuVal.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 55 and 57-64 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-55 of U.S. Patent No. 6,690,780. Although the conflicting claims are not identical, they are not

patentably distinct from each other because to modify the claims of the patent to an initiating communication as well as to an e-mail and instant messaging environment would have been obvious even to one of ordinary skill in the art at the time of the invention since a communication has to be initiated as well as terminated and e-mail and instant messaging are well known in the art as other forms of communication requiring some form of communication processing.

Terminal Disclaimer

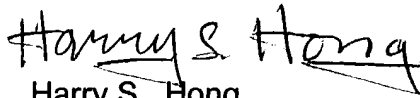
11. The terminal disclaimer filed on August 27, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent No. 6,504,921 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry S. Hong whose telephone number is (703) 306-3040. The examiner can normally be reached on Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad F. Matar can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Harry S. Hong
Primary Examiner
Art Unit 2642

September 26, 2004

Notice of References Cited	Application/Control No. 10/648,871	Applicant(s)/Patent Under Reexamination KOTIK ET AL.	
	Examiner Harry S. Hong	Art Unit 2642	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-6,504,921 B2	01-2003	Kotik et al.	379/201.01
*	B	US-6,690,780 B2	02-2004	Kotik et al.	379/201.01
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

FORM PTO-1449 U.S. Department of Commerce Patent and Trademark Office INFORMATION DISCLOSURE STATEMENT (Use several sheets if necessary)	Serial No. to be determined <u>10/648,871</u>
	Inventors: Kotik et al.
	Docket No. 7158-217

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
H		5,701,340	12/23/97	Zwick	379	204.01	11/20/95
H		5,818,836	10/6/98	DuVal	370	389	8/9/95
H		6,148,067	11/14/00	Leipow	379	201.01	7/2/96

FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER	DATE	COUNTRY	TRANSLATION

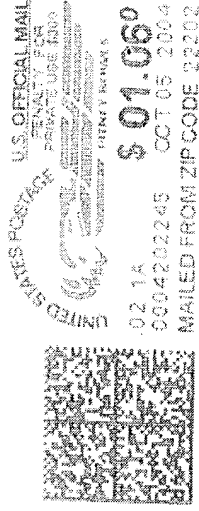
OTHER DOCUMENTS

EXAMINER INITIAL		AUTHOR, TITLE, DATE, PERTINENT PAGES, ETC.

EXAMINER	<u>HONG</u>	DATE CONSIDERED <u>9-26-04</u>
EXAMINER: Initial if citation considered, whether or not citation is in conformance with M.P.E.P. 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.		

Form PTO-1449 [6-4]

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